

Remarks

Applicants have amended the title of the application. Support for the amendment is found in the application as originally filed at least, for example, in claim 19.

Claims 19-28 were pending. Applicants have amended claims 19-23 and 28; canceled claim 26 without prejudice to Applicants' right to pursue its subject matter in the present application and in related applications; and added new claim 33. Thus, upon entry of the present amendment, claims 19-25, 27-28 and 33 will be pending and presented for examination.

Support for the amendments to claims 19 and 22 are found in the international application at, for example, pages 4-5, 8-9 and 12. Additional support for the amendments to claim 22 are found in claim 22 as originally filed. Applicants have amended claims 20, 21, 23 and 28 for clarity (e.g. to recite "a single type of cDNA molecule," or to an insert an article). Basis for the amendments is found, for example, in the original claims. Support for new claim 33 is found, for example, at page 11 of the international application.

None of the amendments introduces new matter into the present application.

Objection to the Title

The Office action objected to the title of the application as allegedly nondescriptive. Applicants have amended the title to recite "Methods For Recovery of DNA From mRNA in Ribosome Display Complexes." Applicants request that the objection to the title be withdrawn in view of the amendment.

Rejections under 35 U.S.C. § 112, second paragraph

The Office action rejected the claims under 35 U.S.C. § 112, second paragraph, as allegedly incomplete for failing to recite that the single primer used in PCT amplification targets the 5' consensus region. Although Applicants disagree that any such recitation is required for compliance with the second paragraph of 35 U.S.C. § 112, Applicants have nevertheless amended the claims to recite that the primer is identical to or overlapping with the 5' sequence of

the RT primer used, or has at least 80% homology to the 5' consensus region of the mRNA and is capable of hybridizing specifically with DNA complementary to a part of the mRNA 5' region in the conditions under which the reaction is performed.

The Office action also alleged that the recitation of “similar” rendered the claims confusing. Without acquiescing to the rejection, and solely to advance prosecution, Applicants have amended the claims to strike any recitations of the word “similar.”

The Office action also alleged that the recitation of “single primer type” was confusing, as the meaning of “type” was allegedly unclear. Applicants have amended the claims to recite a “single type of primer which is identical to or overlapping with the 5' sequence of the RT primer used, or which has at least 80% homology to the 5' consensus region of the mRNA and is capable of hybridizing specifically with DNA complementary to a part of the mRNA 5' region in the conditions under which the reaction is performed.” As amended, the “single type of primer” is unambiguously identical to or overlapping with the 5' sequence of the RT primer used, or has at least 80% homology to the 5' consensus region of the mRNA and is capable of hybridizing specifically with DNA complementary to a part of the mRNA 5' region in the conditions under which the reaction is performed.

The Office action also alleged that claim 19 was confusing because “ribosome display complexes” was recited in the preamble of the claim, but not the body. Although Applicants disagree with this conclusion, Applicants have nevertheless amended the body of claim 19 to recite “ribosome display complexes.”

The Office action also alleged that the meaning of “single molecule” was unclear, stating that “this could mean either one molecule, or only one type of molecule” (Office action, p. 3). Applicants have amended the claims to recite “single type of cDNA molecule.”

The Office action also alleged that the use of the word “optionally” in claim 21 was confusing. Applicants disagree. Use of the word “optionally” does not necessarily render a claim indefinite. See MPEP 2173.05(h)(III):

An alternative format which requires some analysis before concluding whether or not the language is indefinite involves the use of the term “optionally.” In *Ex parte Cordova*, 10 USPQ2d 1949 (Bd. Pat. App. & Inter. 1989) the language

"containing A, B, and optionally C" was considered acceptable alternative language because there was no ambiguity as to which alternatives are covered by the claim. A similar holding was reached with regard to the term "optionally" in *Ex parte Wu*, 10 USPQ2d 2031 (Bd. Pat. App. & Inter. 1989).

Applicants submit that there is no confusion regarding the meaning of the term in the context of claim 21, which for convenience is reproduced below:

21. The method according to claim 19, wherein the ribosome display complexes are treated before step (a) to make the mRNA accessible to one or more primers, optionally by at least one of heating and a chemical method.

Claim 21 recites that the ribosome display complexes are treated before step (a) to make the mRNA accessible to one or more primers. The treatment *optionally*, but not *necessarily*, includes heating, a chemical method, or both. As the scope of the claim is clear, Applicants submit that the claim complies with the definiteness requirement under 35 U.S.C. § 112, second paragraph.

The Office action also alleged that claim 26 was confusing. Applicants have canceled claim 26 without prejudice to their right to pursue its subject matter elsewhere in the present application and in related applications.

The Office action also alleged that claims 22-28 were confusing due to the recitation of "ribosome complexes." Applicants have amended the claims to uniformly recite "ribosome display complexes."

In view of the amendments to the claims, and the arguments presented above, Applicants request that the Office withdraw the rejections of the claims under 35 U.S.C. § 112, second paragraph.

Applicants believe that the claims are in condition for allowance and warmly invite the Office to contact the undersigned attorney to resolve any remaining issues.

Respectfully submitted,

Date: April 7, 2009

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